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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,529	10/02/2000	Neelakantan Sundaresan	AM9-99-0149	5198

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EXAMINER
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GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/676,529

**Applicant(s)**

SUNDARESAN, NEELAKANTAN

**Examiner**

Matthew s Gart

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/30/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

Claims 1-24 are pending in the instant application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Roll (U.S. Patent Application Publication 2002/0016779).**

Referring to claims 1 and 22-24. Roll discloses a method for conducting electronic commerce, comprising:

- Electronically visiting, by a customer interested in shopping for an item, a preselected comparison shopping site, and inquiring about the item and comparative prices thereof (Roll: Figure 13, External pricing information is submitted to the Pricing Engine 801);
- Running, by the preselected CompShop, a query on a plurality of electronic stores carrying the item, and asking for a price of the item, the plurality of electronic stores including at least one smartStore (Roll: paragraph 0062 to paragraph 0064 and claim 1);

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- Determining by the at least one smartStore that the query is received from the preselected CompShop (Roll: paragraph 0062 to paragraph 0064 and claim 1); and
- Selectively determining, by the smartStore, an offer price of the item and selectively returning one of a static price and a modified price resulting from the smartStore learning a best offer price received by the preselected CompShop from the plurality of electronic stores (Roll: paragraph 0062 to paragraph 0064 and claim 1).

Referring to claims 2. Roll further discloses a method comprising returning a static price by at least one of the plurality of electronic stores determined not to be the SmartStore (Roll: Figure 13).

Referring to claims 3. Roll further discloses a method comprising sending, by the SmartStore, a request to the preselected CompShop asking for comparative prices of the item and determining, by the SmartStore, whether an asking offer price is the best offer price that can be offered, wherein if the asking offer price is determined to be a lowest price, then the SmartStore returns its static price (Roll: Figure 13).

Referring to claims 4. Roll further discloses a method of comprising:

- If the asking offer price is determined not to be a lowest price, then adjusting, by the smartStore, the price (Roll: Figure 13); and
- Returning a new price to the preselected CompShop (Roll: Figure 13).

Referring to claims 5. Roll further discloses a method wherein the at least one of the electronic stores automatically changes the price depending on a customer for the

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item asking for the price and what the lowest price is as recorded by the preselected CompShop (Roll: Figure 13).

Referring to claims 6. Roll further discloses a method comprising maintaining, by the smartStore, a list of preselected comparison-shopping sites (Roll: Figure 1).

Referring to claims 7. Roll further discloses a method comprising:

- If a request is made from other than the list of preselected comparison shopping sites, then returning by the smartStore, a static price (Roll: Figure 13); and
- If the request for the price is from the list of preselected comparisons shopping sites, then submitting by the smartStore a request to the preselected CompShop to get a list of all comparison prices for the item (Roll: Figure 13).

Referring to claims 8. Roll further discloses a method comprising when the smartStore obtains the list of all comparison prices, determining whether the smartStore can offer a lowest price (Roll: Figure 13).

Referring to claims 9. Roll further discloses a method wherein the smartStore determines whether it can afford to offer a lower price based upon the comparison and its own cost price and required profit margin (Roll: Figure 13).

Referring to claims 10. Roll further discloses a method comprising if the smartStore can offer a lower price, then returning the lower price to the preselected CompShop (Roll: Figure 13).

Referring to claims 11. Roll further discloses a method comprising if the smartStore cannot offer a lower price, then returning its static price to the CompShop (Roll: Figure 13).

Referring to claims 12. Roll further discloses a method comprising returning, by the preselected CompShop, the list of prices to the customer (Roll: Figure 13).

Referring to claims 13. Roll further discloses a method comprising:

- Selecting, by the customer, based upon prices received, a choice of one of the plurality of electronic stores for providing the item (Roll: Figure 4 and Figure 13).

Referring to claims 14-15. Roll further discloses a method wherein the item comprises a product and service (Roll: paragraph 0020).

Referring to claims 16. Roll further discloses a method wherein the best offer price is the lowest offer price (Roll: paragraph 0001 to paragraph 0009).

Referring to claims 17. Roll further discloses a method wherein the best offer price is the highest offer price (Roll: paragraph 0001 to paragraph 0009).

Referring to claims 18. Roll further discloses a method comprising caching, by the preselected CompShop, the prices received from the plurality of electronic stores (Roll: Figure 10a, Figure 10b, and Figure 11).

Referring to claims 19. Roll further discloses a method comprising caching, by the smartStore, a list of prices received from the preselected CompShop (Roll: Figure 10a, Figure 10b, and Figure 11).

Referring to claims 20. Roll further discloses a method wherein the smartStore selectively visits the preselected CompShop such that information from the preselected CompShop is cached by the smartStore for comparison with a price request occurring between visits to the preselected CompShop (Roll: Figure 10a, Figure 10b, and Figure 11).

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Referring to claims 21. Roll further discloses a method wherein a price comparison is performed on an identical item and a substantially identical item, and wherein a graded price is offered on the substantially identical item (Roll: Figure 10a, Figure 10b, and Figure 11).

### ***Response to Arguments***

Applicant's arguments filed 6/7/2004 have been fully considered but they are not persuasive.

The Attorney argues that Roll, neither discloses nor suggests that an offer price of the item is selectively determined and that one of a static price and a modified price are selectively returned by the smartStore, the modified price resulting from the smartStore learning a best offer price received by the preselected comparison shopping site from the plurality of electronic stores.

The Examiner notes, Roll does disclose (paragraph 0052) a method wherein a user can access a host in order to facilitate the input of an item (i.e., product and service) request. The system determines if the requested item is or will be offered by the host provider. If the host provider offers the requested item, then the requested item request data is dispatched to a pricing engine. The pricing engine provides the price (modified price) that the host provider is willing to extend to the user. The terms of the offer for the item from the host provider is combined with the terms of offer information returned from other product/service providers (static price) to product a consolidated comparative list. This combined data is then formatted for transmission and presentation to the user.

The Examiner further notes, the specification of the instant invention (page 3) discloses that the modified price, results from at least one of the electronic stores learning the best (e.g., lowest or highest offer price depending upon the embodiment)



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price received. Via the modified price a store can appropriately price a commodity if the request is made through a comparison-shopping site.

This is equivalent to the method of Roll, whereby if there is a sufficient price differential for the host provider's minimum margin, then the host provider uses a pricing algorithm or pricing model to produce the terms of offer for the item (paragraph 0063).

The Attorney argues that unlike the host system in Roll that actively adjusts the offered price, the comparison-shopping site of the claimed invention acts as a neutral mediator between competing sites.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

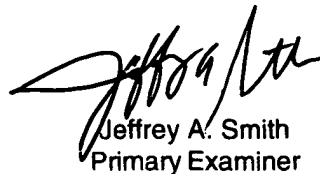
Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG

September 1, 2004



Jeffrey A. Smith  
Primary Examiner